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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.          |
|--|-------------|----------------------|---------------------|---------------------------|
| 10/720,463   | 11/24/2003  | Steven W. Smith      | 0001-0005           | 4082                      |
| 7590   | 09/28/2005  |                      |                     | EXAMINER<br>MAY, ROBERT J |
| Steven W. Smith<br>7237 Birchwood Drive<br>Dallas, TX 75240-3609 |             |                      | ART UNIT<br>2875    | PAPER NUMBER              |

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                  |
|------------------------------|------------------------|------------------|
| <b>Office Action Summary</b> | Application No.        | Applicant(s)     |
|                              | 10/720,463             | SMITH, STEVEN W. |
|                              | Examiner<br>Robert May | Art Unit<br>2875 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 01 August 2005.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 11/24/2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \*    c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Amendment***

Receipt of applicant's amendment/response filed August 1, 2005 is acknowledged. Claims 1-19 are pending, of which claims 1,10, & 13 are amended.

***Response to Arguments***

Applicant's arguments, see Page 6, second paragraph, filed 1 August, 2005, with respect to the rejection(s) of claim(s) 1,6,8-11,13, & 16-17 under U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Blau. The explanations for the rejections using Blau are explained below.

Applicant's arguments and amendments regarding claims 1, 10, & 13 filed have been fully considered but they are not persuasive. Held discloses a design disc which is opaque and transparent in different portions of the disc and therefore the disc is only partially illuminated at the portions that reside over the illumination source when combined with the motorized shaft of Blau (See explanation of rejections under 35 U.S.C. 103(a)).

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the AC/DC converter as claimed in Claim 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1,5-6, 8-10, 12-13,16-17, &19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Held in view of Blau (3,030,944).

Regarding Claims 1,5,6,8,9, 10, 13, 16,17, Held discloses nightlight with a casing (12) and an orifice with a lamp (19) and a design disc (23) where a portion of the disc is illuminated at transparent locations (i.e. cat (25) moon (26)), a plug (15) for an AC power source, but fails but fails to disclose a motor with a shaft that extends through the front side of the casing. However, Blau discloses in Figures 1 and 2, a visual apparatus with a disc (90), which has a spiral design and a motor (24) and drive shaft protruding out from the front of the case (14), which rotates the disc (90) in order to illicit a mental response from the person viewing the visual apparatus. Therefore, it would be obvious

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to modify the nightlight of Held with the motor and drive shaft of Blau in order to elicit a mental response from the viewer.

Regarding Claims 12 & 19, Held discloses a rheostat which controls the intensity of the light (Page 3, 1<sup>st</sup> Col, Lines 25-30) but does not disclose the rheostat as adjusting the speed of a drive shaft, however it is obvious to use the rheostat to adjust the rotational speed of the drive shaft since rearranging of parts involves routine skill in the art see *In re Japikse*.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Held in view of Blau as applied to Claim 1 above, and further in view of Bitting (US Pat 4,491,772).

Claims 2-3 recite respectively, a switch for energizing the light bulb independent of the motor, a switch for energizing the motor independent from the light bulb and a series of resistors for balancing the load between the light bulb and electric motor. Held in view of Blau fails to disclose the two switches and series of resistors. Bitting however discloses a ceiling fan with lights, a motor and a control unit (105) with a switch for activating light independent of the motor and vice versa so that person may have ceiling fan operating in a light source only capacity of vice versa. Therefore it would be obvious to one of ordinary skill in the art to look to ceiling fan art to modify the night light of Held in view of Blau with the switches of Bitting in order to have the night light utilized in a light only capacity and vice versa.

Claim 4 recites a series of resistors used to balance the load between the lamps and the motor, which Held over Blau fail, disclose the series of resistors. However, Bitting discloses in Figure 2, a series of resistors (125 & R22-R27) between the lamp (100) and motor (120). It is generally known to one of ordinary skill in the art that resistors regulate the power by resisting the flow of current. Therefore, it would be obvious to one of ordinary skill in the art to modify the night light of Held in view of Blau with the series of resistors of Bitting in order to regulate the power and balance the load between the light and motor.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Held in view of Blau as applied to Claim 10 above, and further in view of Allen (US Pat 3,080,474). Claim 11 recites that on the illumination area, there is a translucent portion on the front surface of the casing, which Held in view of Blau fails to teach or suggest. Allen discloses a luminous display device in Figure 3 where a translucent white sheet element (88) between the lamp (32) and discs (28 & 30) in order to provide a white softened light in order to illuminate the design discs (28,30). Therefore, it would be obvious to one of ordinary skill in the art to modify the night-light of Held in view of Blau with a translucent sheet of Allen in order to provide a soft white light for the rotating design disc.

Claims 14-15, &18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Held in view of Blau as applied to Claims 13 and 16 above, and further in view of Wang (US Pat 6,513,951).

Regarding Claims 14-15, Claim 14 recites the energizing means for the illumination means as being a battery and Claim 15 recites the rotating means as being a DC electric motor both of which Held in view of Blau fails to teach or suggest. Wang discloses in Figure 7 a portable apparatus for use with a light emitting disk, which has a battery (721) as an energizing means for the illumination means so that the apparatus is portable. One of ordinary skill would be motivated to have a DC electric motor with a battery powered portable night light because conventional batteries provide DC current. Therefore, it would be obvious to one of ordinary skill in the art to modify the night-light of Held in view of Blau with the battery of Wang and to have a DC electric motor in order to make the night-light portable.

Claim 18 recites an AC/DC converter used for converting the alternating current to direct current for the purpose of powering the DC motor which Held in view of Blau fails to teach or suggest. Wang however discloses in Figure 5(a) a DC converter for allowing the lighted disk apparatus to be energized by an indoor socket (Col 4, Lines 3-5). Therefore, it would be obvious to modify the nightlight of Held in view of Blau with the AC/DC converter of Wang so that the motor can run of a standard wall AC power source.

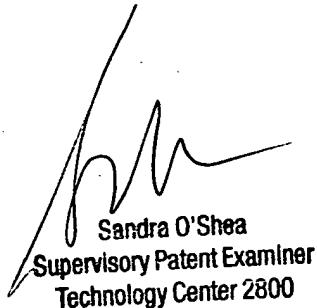
***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Koehler (3,028,482) and Mincy (3,762,082) disclose a lighted display device with a rotating design disc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert May whose telephone number is (571) 272-5919. The examiner can normally be reached between 9 am- 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval PAIR system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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